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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

FABIJANSKI et al

Serial No.: 09/886,208

Filed: June 22, 2001

For: METHODS AND GENETIC  
COMPOSITIONS TO LIMIT  
OUTCROSSING AND UNDESIRE  
D GENE FLOW IN CROP PLANTS

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) Art Unit: 1638  
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) Examiner: David T. Fox  
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RESPONSE TO OFFICE ACTION OF OCTOBER 3, 2002

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Responsive to the office action of October 3, 2002, Group I is provisionally elected with traverse.

Applicants respectfully submit that the restriction between Groups I, II, III and claim 107 in Group IV is improper and Applicants respectfully request rejoinder of Groups II, III and claim 107 (now in Group IV) with provisionally elected Group I for the following reasons.

The Examiner states that Groups I-V are unrelated and that "inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes

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of operation, different functions, or different effects" and cites MPEP § 806.04 as authority. The Examiner further states that: "In the instant case the different inventions have different modes of operation and different effect."

Applicants respectfully disagree.

Groups II, III and claim 107 of Group IV cannot be unrelated from Group I because the claims in Groups II, III and claim 107 of Group IV all depend directly or indirectly on claim 98 in Group I and therefore incorporate all of the limitations of claim 98 in Group I. The claims in Groups II, III and claim 107 of Group IV all define further features of the method recited in claim 98 of Group I and therefore necessarily define features or elements that are capable of use in the methods of Group I.

Applicants further submit that the claims of Group II, Group III and claim 107 of Group IV, all of which define additional features of the method of claim 98 in Group I, do not have "different modes of operation, different functions, or different effects" as contemplated in MPEP § 806.04. The examples of different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects provided in MPEP § 806.04 include (1) a shoe and a locomotive bearing and (2) a process of painting a house and a process of boring a well.

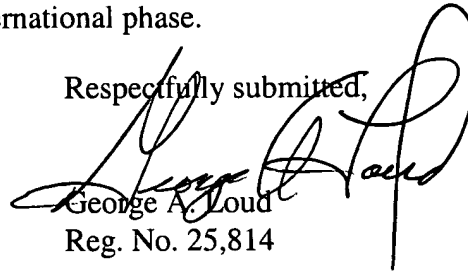
In the examples presented in the MPEP, the articles and methods relate to entirely separate technologies that are independent and unrelated. It is submitted that the instant case is very different. The claims of Groups II, III and claim 107 of Group IV properly depend from claim 98 of Group I and include each step or element of the method of claim 98. Groups II, III and claim 107 of Group IV therefore do not have different modes of operation or different effects in the context in which those terms are used at MPEP § 608.04.

Reconsideration of the restriction requirement and rejoinder of Groups II, III and claim 107 with Group I are therefore respectfully requested.

Applicants also note that the Office Action makes reference to the Article 34 Amendment filed during the international phase on March 21, 2002. The Examiner contends that replacement pages 65-68 and 70-71 have not been entered. This appears incorrect because the International Preliminary Examination Report clearly indicates that the Report is based on replacement pages 65-68, 70 and 71 as amended on March 21, 2001. Thus, the Article 34 Amendments were entered during the international phase and form part of the international application as it entered the United States national phase. That applicants may have filed an unsigned copy of the Article

34 Amendment with the filing under 35 USC 111 does not negate the fact that the Article 34 Amendment was entered earlier, during the international phase.

Respectfully submitted,



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Dated: November 4, 2002

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